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PATENT
Attorney Docket No. GB920000068US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of
Michele CRUDELE et al.
Serial No: 09/766,811
Filed: January 22, 2001
For: PREFERABLE MODES OF
SOFTWARE PACKAGE DEPLOYMENT

Examiner: Tuan A. VU
Art Unit: 2124

CERTIFICATE OF SUBMISSION BY FACSIMILE

PTO FAX NUMBER: 703-872-9306
TOTAL NUMBER OF PAGES: 3

Dear Sir:

I hereby certify that the following documents are being transmitted to the U.S. Patent and Trademark Office on the date shown below:

1. PETITION TO VACATE FINAL REJECTION AS PREMATURE (2 pages); and
2. This CERTIFICATE OF SUBMISSION BY FACSIMILE (1 page).

If you did not receive all the pages, please telephone us at 718-544-1110, or fax us at 718-544-8588.

Respectfully submitted,


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Dated: January 4, 2005

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PETITION TO VACATE FINAL REJECTION AS PREMATURE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Petition is made to the Director under 37 CFR 1.181 to vacate the Final Rejection mailed August 16, 2004.

STATEMENT OF THE FACTS

In the Final Office Action of August 16, 2004, claim 1 was rejected under 35 USC §103 as obvious over U.S. Patent No. 5,845,090 to Collins, III et al. (hereinafter "Collins") in view of U.S. Patent No. 6,505,228 to Schoening et al. (hereinafter "Schoening"), SmartUpdate, "SmartUpdate Developer's Guide", <http://developer.netscape.com/docs/manuals/communicator/jarman/install.htm> (hereinafter "SmartUpdate"), and U.S. Patent No. 6,389,589 to Mishra et al. (hereinafter "Mishra"). Final Office Action, paragraph 4.

In a response filed October 18, 2004, the Applicant stated that no evidence was provided in the Final Office Action that the SmartUpdate document is prior art with respect to the present Application. Amendment and Response to Final Office Action, page 7. The Applicant also requested that the Final Rejection of claim 1 be withdrawn since a *prima facie* case of obviousness was not made in the Office Action. *Id.*, page 7.

Application Serial No 09/766,811

An Advisory Action of December 12, 2004 stated, "First, to clarify on a online reference against which Applicant has raised doubts on publication date, Examiner now submits a page listing all the links leading to the exact copy of SmartUpdate antedating 7/15/2000." Advisory Action, page 2.

ACTION REQUESTED

"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." MPEP 706.07(a) (emphasis added).

The Applicant respectfully submits that the Advisory Action introduces new grounds of claim rejections by the introduction of links to the SmartUpdate copy. The Applicant also submits that these new grounds for rejection were not necessitated by an amendment of the claims nor based on information submitted in an information disclosure statement. Moreover, the Final Office Action did not establish a *prima facie* case of obviousness and should be withdrawn; a fact recognized by the Advisory Action.

Therefore, the Applicant petitions the withdrawal of the Final Rejection and the entry of the Amendment and Response filed October 18, 2004.

No fee is believed due with this Petition, however, should a fee be required please charge Deposit Account 50-0510.

Respectfully submitted,


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Dated: January 4, 2005